

REMARKS

Reconsideration of this application is respectfully requested.

I. Status of the Claims

Claim 6 was previously cancelled and its subject matter incorporated into claim 1. Claim 9 is amended to change its dependency from cancelled claim 6, to pending claim 1. Claim 13 is now cancelled, solely to advance prosecution and not in acquiescence to the rejection. Claims 1-5, 7-12 and 14-47 are pending and under examination.

II. Interview Summary

In addition to the subject matter memorialized in the December 11 Interview Summary, the Examiner also indicated that he intends to conduct further searches of the art even if all present rejections are overcome.

III. The rejection of claim 13 under 35 U.S.C. § 112, second paragraph, is overcome

The rejection of claim 13 is overcome in view of the cancellation of that claim, solely to advance prosecution and not in acquiescence to the rejection.

IV. The rejections under 35 U.S.C. § 103 relies on misunderstanding of the difference between nm and μm

Claims 1-5, 7, 8, 12-22, 26-28, 30-43, and 47 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 4,882,157 to Yang ("Yang") in view of U.S. Patent No. 4,837,255 to Dechow ("Dechow"). Office Action at pages 3-4. In addition, claims 24 and 25 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Yang in view of Dechow and further in view of U.S. Patent No. 4,003,999 to Lybrand ("Lybrand"). Office Action at page 4-5. Applicants respectfully traverse these grounds for rejection.

The rejections rely on the particle size of an active ingredient taught by Dechow which "has an average particle size from 20-100 microns, which overlaps with the instant 'less than about 2000 nm.'" *See* Office Action at page 4. 2000 nm is 2 microns, which is less than 20 microns. Thus, the Examiner's statement that the active agent particle size of the claimed invention and that of Dechow overlap is incorrect.

As to Yang, it is noted that “Yang merely requires ‘fine’ (less than 70 mesh) particles.” 70 mesh corresponds to 210 microns. Thus, Yang does not teach or suggest a composition having Applicants’ claimed active agent particle size of less than 2 microns. Finally, Lybrand is silent as to the particle size of an active agent.

None of the cited references describe, teach or suggest an active agent particle size of less than about 2000 nm, and thus their combination fails to provide an essential element of the claims and cannot, therefore, render obvious such claims. Withdrawal of the rejection is appropriate.

V. Allowance of the present application is appropriate

All of the pending claims are now in condition for allowance and immediate allowance is appropriate. In the interview the Examiner indicated the intent to conduct further searches. Applicants respectfully assert that under the circumstances further delay of allowance is unnecessary and inequitable.

This application has been under *examination* since 2006, and has gone through two RCEs. Presumably the art has been thoroughly searched and it is unclear what can be gained by further searching. Therefore, further searching is unnecessary.

Delay is inequitable under the circumstances because any present delay in allowance is due to the PTO and not Applicants. After Applicants overcame the April 16, 2008, Office Action, the November 16, 2008 Office Action asserted *new* grounds of rejection. That the claims were amended does not suffice to present a colorable reason for new search and examination, because the rejection is based not on any new elements introduced into the claims, but on elements that were present in the *original* claims.

Most notably, claim 13 (rejected under 35 U.S.C. § 112, second paragraph) is an original claim and so the rejection of claim 13 could have been made earlier.

The obviousness rejection of claims 1-5, 7, 8, 12-22, 24-28, 30-43 and 47 is directed against a combination of 3 elements: size of particle, active agent with surface stabilizer and water content. Original claim 1 recites the size of particle, and active agent with surface

stabilizer. Original claim 5, which depended from 1, recited the water content. If the prior art taught all 3 elements, as asserted in the November 16 Office Action, it would have been sufficient to render obvious the *original* claims (including claims 1 and 5) merely by the presence of any 2 elements.

Therefore all of the present rejections *could have* been asserted earlier in prosecution. To further extend prosecution by presenting additional arguments is prejudicial to Applicants. MPEP § 707.07(g) states that “[p]iecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references.”

Should the PTO desire further search and examination of the application, notwithstanding the merit of the above arguments, Applicants respectfully request that the PTO present *all* grounds of rejection so that they can be dealt with in a single reply, and without further delay in prosecution. Applicants seek efficient and prompt examination of the present claims.


CONCLUSION

All claims are allowable. If there are any questions regarding the application, the Examiner is invited to contact the undersigned at the number below.

The Commissioner is hereby authorized to credit any overpayment, or charge any additional fees which may be required under 37 C.F.R. §§ 1.16-1.17, to Deposit Account No. 19-0741. Applicants hereby petition under 37 C.F.R. §1.136 for any extensions of time required, and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date December 16, 2008
FOLEY & LARDNER LLP
Customer Number: 31049
Telephone: (202) 295-4726
Facsimile: (202) 672-5399

By 
Simon J. Elliott, Ph.D.
Attorney for Applicants
Registration No. 54,083